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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/047,122	01/15/2002	John I. Shipp	115.0001-00000	9694

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EXAMINER

O CONNOR, CARY E

ART UNIT PAPER NUMBER

3732

DATE MAILED: 08/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/047,122

Applicant(s)

SHIPP ET AL

Examiner

Cary E. O'Connor

Art Unit

3732

— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 June 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6-11, 13-23, 25, 26, 28-36, 38-59, 61-72, 77-86, 89-92 and 99-119 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 6-11, 13-23, 25, 26, 28, 38-59, 61-72, 89-92 and 99-119 is/are allowed.
- 6) ☒ Claim(s) 77-86 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

The indicated allowability of claims 77-86 is withdrawn in view of the newly discovered reference(s) to Pierce (5,893,878). Rejections based on the newly cited reference(s) follow.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 77-81, 83-86 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoon (,550) in view of Pierce (5,893,878). Yoon shows a grasper 30 comprising a shaft 36 having a trailing end, a leading end, and a lumen therebetween. The grasping surfaces 38, 40 do not include surface roughenings configure to generally point towards the trailing end of the shaft. Pierce shows a tissue grasper having grasping surfaces with surface roughenings 24 configure to generally point towards the trailing end of the shaft. This configuration allows the tissue to be grasped without affecting the structural integrity of the tissue. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the grasping surfaces of Yoon with surface roughenings configure to generally point towards the trailing end of the shaft, as taught by Pierce, so the tissue may be grasped without affecting the structural integrity of the tissue. As to claim 78, element 32 can be considered a depth limiting protrusion. As to claims 79-81, the dimensions of the grasper are considered to have been an obvious

design choice to one of ordinary skill in the art, depending on the procedure to be performed by the grasper. As to claim 84, note the seal 84.

Claims 77-83 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sorensen et al (5,320,627) in view of Pierce (5,893,878). Sorensen shows a grasper 10 comprising a shaft 14 having a trailing end, a leading end, and a lumen therebetween. The grasping surfaces 16 do not include surface roughenings configure to generally point towards the trailing end of the shaft. Pierce shows a tissue grasper having grasping surfaces with surface roughenings 24 configure to generally point towards the trailing end of the shaft. This configuration allows the tissue to be grasped without affecting the structural integrity of the tissue. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the grasping surfaces of Sorensen with surface roughenings configure to generally point towards the trailing end of the shaft, a taught by Pierce, so the tissue may be grasped without affecting the structural integrity of the tissue. As to claim 78, element 32 can be considered a depth limiting protrusion. As to claims 79-81, the dimensions of the grasper are considered to have been an obvious design choice to one of ordinary skill in the art, depending on the procedure to be performed by the grasper. As to claim 82, note that there is four grasping surfaces at the leading edge.

Allowable Subject Matter

Claims 6-11, 13-23, 25-26, 28-36, 38-59, 61-72, 89-92, 99-116 are allowed.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cary E. O'Connor whose telephone number is 703-308-2701. The examiner can normally be reached on M-Th 7:00-3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Shaver can be reached on 703-308-2582. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Cary E. O'Connor
Primary Examiner
Art Unit 3732

ceo
August 8, 2004